REMARKS/ARGUMENTS

Reconsideration of the subject application is requested.

In the present Office Action, the Examiner objected to the Abstract as being too short to describe the disclosure; objected Claim 14 for typographical error; rejected Claims 15-16 under 35 U.S.C. 112, second paragraph, as being indefinite; rejected Claims 1-38 under 35 U.S.C. 101 as being directed to non-statutory subject matters; rejected Claims 1-38 under 35 U.S.C. 101 for lacking of a specific and substantial utility or a well-established utility; rejected Claims 1-38 under 35 U.S.C. 112, first paragraph, for not being supported by a specific and substantial utility or a well-established utility; rejected Claims 1-38 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 7,065,740 to Westerinen et al. (hereinafter "Westerinen"); rejected Claims 1-38 under 35 U.S.C. 102(b) as being anticipated by EP 1,061,445 to Sun Microsystems (hereinafter "Sun"); and rejected Claims 1-38 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,317,748 to Menzies et al. (hereinafter "Menzies").

In this response, Applicant presents various amendments and remarks believed to remedy the Examiner's objections and rejections, and place the claims in condition for allowance.

Claims 1-4, 6-9, 13-26, and 28-38 remain in the application.

Amendments to Abstract, Claims 14-16, 36, and 38

As required by the Examiner, Applicant has corrected the Abstract so that it adequately describes the disclosure.

As required by the Examiner, Applicant has corrected the typographical error in Claim 14.

Applicant agrees with the Examiner's observation on original Claim 15, that is, "the entity module" should be "the entity management module".

As required by the Examiner, Applicant has amended Claim 16 to cite the appropriate antecedent basis.

Applicant has spotted a clerical error in Claim 38, "to interact wit the entity". Applicant has amended the phrase to "to interact with the entity".

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Applicant has spotted another clerical error in Claim 36, "wev server". Applicant has amended the phrase to "web server".

The Subject Embodiments

As exemplified in Figure 20 and Table 1, the subject embodiments provide a provisioning services platform that automatically and remotely regulates service subscription and supplies replenishment that are currently performed manually. The embodiments provide services such as automated meter reads, tracking toner usage, automated supplies ordering, monitoring media path jams, productivity reporting, software download, assisted user self-help, remote diagnostics, and prognostics. The embodiments provide numerous benefits such as timely and accurate delivery of supplies without human intervention; decreased inventories; simple relationships between users and devices; and cost savings and reduced service engineer usage.

A provisioning server in the platform runs a service consumer interface; an entity management module including information on machines usable with the platform such as an electroreprographic marking machine, a facsimile machine, a scanning device, a multifunction device, an user marking machine, a printer, or a copier; a policy and preferences module; an order processing module that directs order processing from service sponsors as well as those created by the policy and preferences module, interacts with other modules to fulfill order requirements, and tracks order status; a registration module; a service definitions module; a service developer interface module; and a service participant interface module.

Amendments to Claim 1

Claim 1 has been amended to specify the functions of two elements, the entity management module and the order processing module. Support for the amendments can be found in, for example, Figure 20; TABLE 1; from Paragraph [0112] to Paragraph [0120]; and original claims 3, 5, 10, 11, 12, 15, 17, 22, and 23. Particularly, support for reciting the machines usable with the platform can be found in, for example, Paragraph [0003] and Paragraph [0034]. No new matter is introduced.

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Statutory Subject Matter of Claim 1

Applicant respectfully submits that Claim 1 is a product/apparatus claim; and it is not, as the Examiner asserted, "mere software per se".

Claim 1 is not directed to computer listings per se, i.e., the descriptions or expressions of the programs, and is therefore statutory under MPEP 2106.01.I.

"When a computer program is recited in conjunction with a physical structure... USPTO personnel should treat the claim as a product claim". Please see MPEP 2106.01.I.

Utility of, and Enabling Support for, Claim 1

Applicant respectfully submits that the embodiment defined by Claim 1 produces numerous "useful, concrete and tangible" results, by way of example, as enumerated below:

(1) Automating current, manually-performed and/or non-uniform data acquisition processes; Paragraph [0013]

(2) Specific examples of services include automated meter reads, automated supplies ordering, productivity reporting, software download, assisted user self-help, remote diagnostics, and prognostics; Paragraph [0019]

(3) Tracking toner usage, area coverage, and toner bottle change events to ensure the timely and accurate delivery of meter supplies to the user's site without human intervention. Paragraph [0185]

(4) Remote monitoring media path jams, image area coverage, media usage (weight, size, and type), feature usage, toner status, simplex/duplex quantities, media tray usage, reduction and enlargement, copy modes, and High-Frequency Service Items status, among others. Paragraph [0185]

(5) Automated supplies ordering can enable decreased inventories through increased accuracy of tracking consumables at user sites; Paragraph [0018]

(6) Simplifying the users' relationships with devices such as marking devices; Paragraph [0013]

(7) Walking users through any operation they wish to perform, including small repairs and replacements of user replaceable units; Paragraph [0023]

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(8) Providing cost savings from reduced service engineer usage through increased user self-help, remote diagnostics, and prognostics; Paragraph [0018]

(9) Providing new workflows to address evolving user requirements; Paragraph [0013]

(10) Devices take on an active role in providing users with enhanced post sale experiences; Paragraph [0014]

(11) Enabling devices and device proxies to be deployed and work together seamlessly; Paragraph [0017] and

(12) Eliminating phone time due to fewer call-in orders and disputes. Paragraph [0018]

The utility prong of 35 U.S.C. 101 is closely related to the "how to use" aspect under 35 U.S.C. 112, first paragraph. As such, Applicant respectfully submits that the specific and substantial utility of Claim 1 overcomes the Examiner's rejections under both sections of 35 U.S.C.

Patentability of Claim 1

Claim 1 is limited by a specific combination of an entity management module and an order processing module. The entity management module comprises a repository of entity information including information on machines usable with the platform, wherein said machines comprise an electroreprographic marking machine, a facsimile machine, a scanning device, a multifunction device, an user marking machine, a printer, or a copier. The order processing module directs order processing from service sponsors as well as those created by the policy and preferences module, interacts with other modules to fulfill order requirements, and tracks order status.

Westerinen fails to teach or suggest the machines usable with the platform of Claim 1. Westerinen is intended to automate the deployment, provisioning, and management of a programmable device or computing device. Westerinen teaches that it is "operational with" programmable devices such as "personal computers, server computers, hand-held or laptop devices, multiprocessor systems, microprocessor-based

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systems, set top boxes, programmable consumer electronics, network PCs, minicomputers, mainframe computers". (Lines 13-22, Column 5)

Westerinen also fails to teach or suggest the order processing module with those specific functions as defined in Claim 1. In his automating procedure, Westerinen teaches a plurality of sets of procedures. The "sets of procedures include a testing/development procedure, a planning procedure, a deployment procedure, a prepping procedure, and a provisioning procedure". (Lines 40-45, Column 2) "In the planning procedure, <u>a need is anticipated and quantified</u> for bringing on additional capacity and resource planning is performed to meet the need." (Lines 49-52, Column 2)

Sun fails to teach or suggest many limitations of Claim 1, including the specific combination of an entity management module and an order processing module as described above. Sun teaches only a transport neutral technique that allows a management application to communicate with a computer system using any of a group of network protocols. The management application software in Sun is independent of the transport mechanism used and need not be changed if the transport mechanism changes.

Similarly, Menzies fails to teach or suggest many limitations of Claim 1, including the specific combination of an entity management module and an order processing module as described above. Menzies is intended to practice with computer system configurations, including hand-held devices, multi-processor systems, microprocessor-based or programmable consumer electronics, network PCs, minicomputers, mainframe computers and the like. (Lines 1-8, Column 4) Menzies discloses a method of mapping between SNMP MIB module schema and Common Information Model (CIM) schema. MIB modules are tree-structured lists of objects for describing SNMP network device information, whereas CIM schema employs user-intuitive, object-oriented classes to model such information. The order processing module of Claim 1 has never been touched on by Menzies.

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Patentability of All Other Claims

Independent Claim 26 has been amended to include all the limitations that Claim 1 has. As such, Claim 26 is patentable for the same reason as indicated above.

All other claims depend directly or indirectly from either Claim 1 or Claim 26, and they are therefore all patentable.

CONCLUSION

Given the foregoing arguments, Applicant asserts that the rejection has been fully responded to and overcome. All pending claims are patentable. Therefore, Applicant respectfully requests that a Notice of Allowance be issued in this application.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby authorized to call Patrick R. Roche, at Telephone Number (216) 861-5582.

Respectfully submitted,

FAY SHARPE LLP

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Date
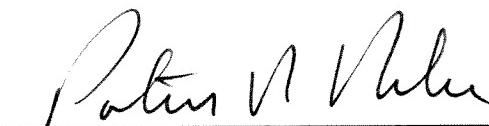
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